

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orbital Sciences Corp.

Serial No. 75/081,396

Harold E. Meier of Baker & Botts. L.L.P. for Orbital
Sciences Corp.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Hanak and Rogers, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 1, 1996, applicant applied to register the
mark "SMARTTRACK JR." for what was subsequently identified
by amendment as a "vehicle tracking and information system;
namely, computer software for tracking vehicles and
processing GPS position information regarding the location
and status of such vehicles; monitors for displaying
vehicle location information; and communications

equipment[,] namely transmitters and receivers for relaying vehicle location information between dispatchers and vehicle operators," in Class 9. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in connection with these goods in commerce.

Registration was refused under Section 2(d) of the Lanham Act because the Examining Attorney determined that applicant's mark, if it were used in connection with the goods specified in the application, would so resemble the registered¹ mark shown below that confusion would be likely.

Although the computer-generated image shown above is not clear, the illegible wording along the bottom line reads as follows: "THE INTELLIGENT WAY TO TRACK YOUR FREIGHT ANYWHERE." The design on the left side of the mark is described in the registration as a representation of "a

¹ Reg. No. 2,028,075, issued to TNT CANADA INC., a Canadian corporation, on January 7, 1997, but the priority date for the

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registration and the filing date of that application both predate the filing of the instant application.

satellite." The registration identifies the services rendered under the mark as "computerized satellite tracing of vehicles and their shipments," in Class 35, and "truck transport services," in Class 39.

In support of his refusal to register, the Examining Attorney made of record a dictionary definition of the word "trace" which shows that it is almost synonymous with the word "track." Additionally, the Examining Attorney submitted excerpts retrieved from two searches for the term "vehicle tracking" on Internet databases using two different search engines, AltaVista and Yahoo. Also made of record were excerpts from published articles retrieved from the Dialog® database. Not surprisingly, articles and advertisements for firms providing the service of vehicle tracking were located under this topic, as were articles and advertisements for companies which sell the computer and telecommunication equipment which is used in rendering the service of tracking vehicles.

When the refusal to register was made final, applicant appealed. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the record and arguments before us, we hold that the refusal to register is not sufficiently supported in this case.

Both applicant and the Examining Attorney agree that the test for resolving the issue of whether confusion is likely is set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The Examining Attorney's application of this test leads him to conclude that "... for all intents and purposes, the marks are identical: they convey the identical commercial impression, and are highly similar visually and in pronunciation." (Office Action No. 3, Aug. 28, 1998.) Further, he finds that the evidence of record "clearly shows that not only may the same companies offer both GPS tracking software products and services," but also that "purchasers of the respective goods and services for GPS vehicle location and tracking are not mutually exclusive, but would be exposed, at the same time, to material featuring both GPS positioning goods and services." (Examining Attorney's brief, unnumbered p. 6).

Applicant argues that the registered mark is diluted, that the marks of applicant and registrant differ with regard to appearance and pronunciation, and that, in connection with the respective goods and services herein at

issue, they create different commercial impressions. Additionally, applicant concedes that registrant provides a vehicle tracking service, but argues that just because both parties' goods or services have something to do with computers and vehicle tracking, confusion is not necessarily likely, given that the classes of purchasers of applicant's goods and registrant's services are mutually exclusive.

The Board is not persuaded by applicant's arguments that these marks are not similar. Although many distinctions can be made between these marks, they are nonetheless similar because the dominant portion of applicant's mark is "SMARTTRACK," which is very similar to "SMART TRAX," the dominant element in the cited registered mark. Both of these terms have similar, suggestive connotations in connection with the goods set forth in the application and the services specified in the cited registration. "SMARTTRACK JR." might well be interpreted as a recent addition to the "SMART TRAX" line of freight tracking services. If the goods and services, as identified in the application and the cited registration, respectively, were closely related in the commercial sense, the use of these two similar marks in connection with them

would be likely cause confusion. The record, however, does not show this to be the case.

Applicant concedes that its goods are related to the services set forth in the cited registration in the sense that purchasers of tracking software and hardware may include providers of vehicle tracking services. As noted above, however, applicant contends that the purchasers of its goods are mutually exclusive from the purchasers of the services set forth in the registration.

The Examining Attorney had the burden of establishing not just that the marks are similar, but also that applicant's goods are commercially related to the services specified in the registration in such a way that confusion would be likely if applicant were to use its mark on the goods set forth in the application. Contrary to the contention of the Examining Attorney, however, it is not at all clear from the evidence he submitted that any one company provides both the equipment used to track vehicles and the service of tracking vehicles, much less than a single business does both under one mark. None of the materials retrieved from the three sources clearly establishes that one may buy computerized vehicle tracking and communications equipment from the same company which renders vehicle tracking services, much less that the same

mark is used to identify both the service and the equipment used in rendering the service. This evidence does not demonstrate a basis upon which we can conclude that potential purchasers of vehicle tracking computer software, hardware and communications equipment are also prospective customers for the services of tracking vehicles.

To the contrary, reason would lead us to adopt applicant's contention that whereas applicant's software and hardware will be purchased by businesses which use such equipment to track vehicles, businesses using this equipment to track vehicles are not themselves potential purchasers of vehicle tracking services.

The record in this application does not support the conclusion urged by the Examining Attorney. Neither the Dialog® evidence nor the Internet evidence listing, under the heading of "vehicle tracking," of both vehicle tracking services and various items of equipment used to track vehicles, demonstrates that the services are promoted to the same customers to whom the equipment is sold. "Vehicle tracking" is just a heading under which both the services and the goods naturally fall. The evidence does not establish that the respective goods and services of applicant and registrant move through common trade

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channels, that both would be marketed under a single mark,
or that both would be purchased by a single entity.

The record therefore does not show that confusion with
the registered mark would be likely if applicant were to
use its mark in connection with the goods set forth in this
application. Accordingly, the refusal to register is
reversed.

R. F. Cissel

E. W. Hanak

G. F. Rogers
Administrative Trademark Judges
Trademark Trial & Appeal Board

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